

## REMARKS

The present amendment is prepared in accordance with the requirements of 37 C.F.R. § 1.121. The clean copy of the claims is provided above. The marked-up copy of the claims is attached on separate sheets. In the marked-up version of the claims, inserted material is underlined and deleted material has a line there through.

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

### **35 U.S.C. § 101 Issues**

The Examiner has rejected claims 1-5, 6-15, 22, 32, and 34-37 under 35 U.S.C. § 101 as non-statutory. Specifically, the Examiner states that applicants have not given any process or structural means for carrying out the invention. Moreover, the Examiner states that claims 1 and 22 do not produce a tangible result, and claims 32 and 34-37 define instructions for execution on a computer.

Applicants have amended claims herein to address the Examiner's rejections and more fully claim the process of the invention. Applicants have amended claim 1 to identify and clarify that the process is for an Internet search (specification, p.7, ll.14-17), and to include the method limitations of claim 4, to wit: producing a keyword; searching for an associated advertisement; matching the associated advertisement; and correlating the advertisement with the search results items. These process steps distinctly identify the unique method of the instant invention. By its inclusion into claim 1, Applicants have deleted original claim 4. Applicants respectfully submit

that claim 1 has been put into a condition for allowance over the 35 U.S.C. § 101 rejection, and that claims 2, 3 and 5, dependent upon the base limitations of claim 1, are also placed in a condition of allowance. Furthermore, Applicants have amended claim 6 to be dependent upon newly amended claim 1, thereby making claim 1 the independent base claim for claims 7-15, inclusive.

The Examiner has rejected claim 22 as not producing a useful, concrete and tangible result. Claim 22 encompasses a program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps of the instant invention. Claim 22, ll.1-2. Applicants have further defined the claim scope as targeting an associated advertisement from an Internet search having access to an information repository by a user. Specification, p.3, ll.21-23; p.7, ll.14-17. Consistent with the rejection to claim 1, Applicants have amended claim 22 to include detailed process limitations unique to the instant invention, including combining the limitations of claim 24 within claim 22, to wit: producing at least one keyword from a search result (Specification, p.10, ll.9-11); searching for an associated advertisement within the repository using the keyword (Specification, p. 10, ll.12-13); identifying the associated advertisement from the repository having a word that matches the keyword (Specification, p.10, ll.12-18); and correlating the associated advertisement with the user search result items (Specification, p.11, ll.14-18). By its inclusion into claim 22, Applicants have deleted original claim 24. Applicants submit that newly amended claim 22 is now placed in a condition for allowance, claiming a useful, concrete and tangible result.

The Examiner has rejected claims 32 and 34-37 as non-statutory, the claims defining instructions for execution on a computer, i.e., a computer program. With respect to claim 32,

Applicants have claimed the architecture of a computerized "system" that executes the methodology of the instant invention. The architecture includes the following subsystems: a) product database; b) user/session manager; c) product matching manager; d) product listing manager; and e) result presentation manager. Specification, p. 9, ll.14-18. To this endeavor, Applicants have amended the elements of claim 32 to provide more specificity to the functional interrelationships between the claim elements that permit the computer program's functionality to be realized, and to claim the means for performing these functions.

Regarding claims 34-37, Applicants have amended each of these to specifically claim the computer program code's means for causing each function. The claimed invention is a computer program product that comprises a computer usable medium having a new, useful, and nonobvious combination of computer readable program code "means" embodied thereon. The claims are drawn to the computer program product itself having "program code means" in computer readable form on a computer usable medium. For claims 34-37, the invention lies in the "program code means" of a computer program product.

Applicants respectfully submit that the claims, as amended, have overcome the 35 U.S.C. § 101 rejections, and as such are placed in a condition for allowance.

### **35 U.S.C. § 102 Issues**

The Examiner has rejected claims 1-12, 15-20, 22-29, and 31-35 under 35 U.S.C. § 102 as being anticipated by Skillen et al. (WO 98/36366). The Examiner states that Skillen teaches a method for targeting based upon an information repository search by a user, associating an advertisement with a result from the information repository search, providing an advertisement on demand, targeting related advertisements to individual search result items from a search of an

information repository, submitting a query to the information repository, and obtaining individual search result items. Applicants respectfully disagree for the reasons stated herein.

A key distinction between Skillen and the present invention concerns the activities of Skillen's associative search engine. Skillen teaches that the associative search engine correlates "a *search argument* derived from the user and changes in the *argument* during a single session, to particular product data within the product database 24." Skillen, p.7, ll.1-3 (emphasis added). Furthermore, Skillen discloses that "[t]he associative search engine 18 may determine a logical fit to the *initial search argument*, or it may create a logical tree analysis of possible product fits." Skillen, p.7, ll.21-23 (emphasis added). Importantly, Skillen teaches deriving product data from an initial search argument, and determining a logical fit to the initial search argument. The present invention discloses, teaches, and claims identifying associated advertisements from the search result, not the search argument.

The method of the instant invention follows an approach uniquely different from the e-commerce method of user profiling. Instead of using user profiles to target advertisement, the *resultant search items* from a search engine performing an Internet search are utilized.  
Specification, p.7, ll.14-17.

For example, if a software developer is searching for a specific piece of software code, a query will be entered to initiate a search on an Internet search engine, e.g., www.yahoo.com, or www.ibm.com/java. The search engine then returns a specific search result set showing items which may contain the sought after information. *For each search result item, a graphical user interface (GUI) selection is presented*, allowing the user to select the GUI, on demand, if so desired, to investigate related advertisements.  
Specification, p.7, ll.19-25 (emphasis added).

Referring to Fig. 1 of the present invention, the proposed method involves submitting a query to the search engine 10, and matching abstract text to products 40 *for each search result item* 30. A comparison to the initial search argument, as required and disclosed by Skillen, is not

performed by the instant invention. Applicants submit that each independent claim, as amended, specifically requires analyzing the search result of the user's search, and not the search argument. Claim 1, 1.5; Claim 16, 1.3; Claim 22, 1.7; Claim 26, 1.5; Claim 31, 1.5; Claim 32, 11.10-12; Claim 34, 11.8-9; Claim 35, 11.3-4. Analyzing the search results is key to the present invention, and patentably distinct over the cited prior art.

[U]nlike the prior art methods of selecting and displaying banner ads predicated on user profiles, these profiles need not be relied upon. *Instead the initial search results themselves are utilized.* These search results provide a more narrowly defined basis for selecting target advertisements for each user. Specification, p. 8, 11.7-11 (emphasis added).

Applicants respectfully submit that the claims, as amended, are patentable over the cited prior art of Skillen for the reasons stated above, and further submit that all claims dependent upon the independent claims having this claim limitation are also patentably distinct.

### **35 U.S.C. § 103 Issues**

The Examiner has rejected claims 13, 14, 21 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Skillen. For the reasons cited above, Applicants submit that the instant invention is patentable over Skillen, including the independent claims, as amended, from which these rejected claims depend.

It is respectfully submitted that the application has now been brought into a condition where allowance of the entire case is proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited. Should the Examiner not find the claims to be allowable,

Applicants' attorney respectfully requests that the Examiner call the undersigned to clarify any issue and/or to place the case in condition for allowance.

Respectfully submitted,




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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Assistant Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Name: KARA LAUMIA Date: 3.7.03 Signature:   
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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

### In the Claims

Claims 4 and 24 were canceled.

Claims 1-3, 6-14, 22-23, 32, and 34-37 were amended as follows:

1     1.     ~~(amended)~~ A method ~~for~~ of targeting ~~advertising~~ an associated advertisement  
2     ~~from an Internet search having based upon access to~~ an information repository by a  
3     ~~user search by a user, comprising associating an advertisement with a result from the~~  
4     ~~information repository search;~~  
5     producing at least one keyword from a search result of said Internet search by said  
6     user;  
7     searching for said associated advertisement within said repository using said at least  
8     one keyword;  
9     identifying said associated advertisement from said repository having a word that  
10    matches said at least one keyword; and  
11    correlating said associated advertisement with user search result items.

1     2.     ~~(amended)~~ The method of claim 1 further comprising providing ~~the said~~  
2     associated advertisement on demand by said user.

1     3.     ~~(amended)~~ The method of claim 1 wherein said information repository is  
2     associated with ~~a~~ an Internet server.

1     4.     ~~The method of claim 1 wherein the associating step comprises:~~  
2     ~~analyzing the search result to produce at least one keyword;~~

3       ~~using said keyword to search for the associated advertisement within said repository;~~  
4       ~~identifying the associated advertisement from said repository having a word that~~  
5       ~~matches said keyword as related to said search result; and,~~  
6       ~~correlating the associated advertisement with said search result.~~

1       6.     ~~(amended) A~~ The method of claim 1 ~~for targeting related advertisements to~~  
2       ~~individual search result items from a search of an information repository, further~~  
3       ~~comprising:~~

4       ~~matching said individual search result items to said related advertisements; and,~~  
5       ~~designating those of said individual user search result items matched to said related~~  
6       ~~associated advertisements for subsequent selection by a user.~~

1       7.     ~~(amended)~~ The method of claim 6 further comprising first submitting a query to  
2       said information repository and obtaining said ~~individual user~~ search result items.

1       8.     ~~(amended)~~ The method of claim 6 wherein designating said ~~individual user~~  
2       search result items further comprises displaying a graphical user interface to said user.

1       9.     ~~(amended)~~ The method of claim 6 wherein said ~~related associated~~ advertisements  
2       comprise related product advertisements.

1       10.    ~~(amended)~~ The method of claim 6 further comprising assigning a user identifier  
2       prior to matching said ~~individual user~~ search result items to said ~~related associated~~  
3       advertisements.

1       11.    ~~(amended)~~ The method of claim 6 further comprising formatting said ~~related~~  
2       ~~associated~~ advertisements matched with said ~~individual user~~ search result items so  
3       designated, prior to displaying said related advertisements.



12. (amended) The method of claim 6 further comprising storing said ~~related~~  
associated advertisements using a URL as an identifier for each of said ~~individual-user~~  
search result items.

13. (amended) The method of claim 6 further comprising performing an off-line  
batch process for each of said ~~individual-user~~ search result items, wherein said batch  
process identifies said ~~related-associated~~ advertisements for said search result items.

14. (amended) The method of claim 6 further comprising providing a true/false  
designator to a user, wherein said designator indicates whether said ~~related-associated~~  
advertisements exist for said ~~individual-user~~ search result items.

22. (amended) A program storage device readable by a machine, tangibly  
embodying a program of instructions executable by the machine to perform the method  
steps for targeting an associated advertisement from an Internet search having access to  
an information repository by a user~~targeting advertising based upon an information~~  
~~repository search by a user~~, comprising: ~~associating an advertisement with a search~~  
~~result from the information repository search~~

producing at least one keyword from a search result of said Internet search by said  
user;

searching for said associated advertisement within said repository using said at least  
one keyword;

identifying said associated advertisement from said repository having a word that  
matches said at least one keyword; and

correlating said associated advertisement with user search result items.

1 23. (amended) The program storage device of claim 22 further comprising providing  
2 said associated advertisement on demand by said user.

1 24. ~~The program storage device of claim 22 wherein the associating step comprises:~~  
2 ~~analyzing said search result to produce at least one keyword;~~  
3 ~~using said keyword to search for the associated advertisement within said repository;~~  
4 ~~identifying said associated advertisement from said repository having a word that~~  
5 ~~matches said keyword as related to said search result; and,~~  
6 ~~correlating said associated advertisement with said search result.~~

1 32. (amended) A system for providing ~~related~~-associated advertisements for search  
2 result items from a ~~an~~ Internet search of an information repository, comprising:

3 a user/session manager means for adapted to maintain and track~~maintaining and~~  
4 tracking search result items from user sessions, user queries, and advertisement  
5 requests;

6 a product database ~~adapted to~~means for provide-providing storage and retrieval for  
7 said ~~related~~-associated advertisements;

8 a product matching manager means for adapted to analyze~~analyzing~~ said search  
9 ~~result items~~user sessions, said user queries, and said advertisement requests from  
10 said user/session manager and match-matching said ~~related~~-associated  
11 advertisements from said product database corresponding to each of said search  
12 result items;

13 a request server ~~adapted to display~~means for displaying results from said search and  
14 ~~to display~~displaying said ~~related~~-associated advertisements from said product  
15 matching manager; and,

16 a product presentation manager ~~adapted to reference~~means for referencing and ~~retrieve~~  
17 retrieving said ~~related~~-associated advertisements that correspond to each of said search  
18 result items, in said product database, and to formulate said ~~related~~-associated  
19 advertisements into a list, and pass said list to said request server.

1 34. (amended) A computer program product for providing related advertisements for  
2 search result items from a search of an information repository, comprising:

3 a computer readable program code means for causing a computer to effect  
4 maintaining and tracking user sessions, user queries, and advertisement requests;

5 a computer readable program code means for causing a computer to effect providing  
6 storage and retrieval of said related advertisements;

7 a computer readable program code means for causing a computer to effect analyzing  
8 said search result items and matching said related advertisements corresponding  
9 to each of said search result items;

10 a computer readable program code means for causing a computer to effect  
11 displaying results from said search and displaying said related advertisements;  
12 and,

13 a computer readable program code means for causing a computer to effect  
14 referencing and retrieving said related advertisements corresponding to each of  
15 said search result items, formulating said related advertisements into a list, and  
16 presenting said list to a user.

1 35. (amended) A computer program product for selecting related advertisements for  
2 search result items from a search of an information repository, comprising:

3 a computer readable program code means for causing a computer to effect matching  
4 said search result items to said related advertisements;

5 a computer readable program code means for causing a computer to effect  
6 designating each of said search result items that have said related advertisements  
7 matched therewith;

8 a computer readable program code means for causing a computer to effect providing  
9 a corresponding graphical user interface for each of said search result items so  
10 designated for subsequent selection by a user;

11 a computer readable program code means for causing a computer to effect searching  
12 and retrieving said related advertisements for one of said search result items  
13 when said corresponding graphical user interface is selected by said user; and,  
14 a computer readable program code means for causing a computer to effect  
15 formatting and displaying said related advertisements upon selection.

1 36. (amended) The computer program product of claim 35 further comprising  
2 a computer readable program code means for causing a computer to effect  
3 submitting a query to said information repository; and,  
4 a computer readable program code means for causing a computer to effect obtaining  
5 said search result items from said information repository;

1 37. (amended) The computer program product of claim 36 further comprising a  
2 computer readable program code means for causing a computer to effect assigning an  
3 identifier for said user when said query is submitted to said information repository.